REMARKS/ARGUMENTS

Summary

Claims 20-32 are pending. Claims 20 and 30 have been amended. No new matter has been added.

Objection to Claims

Claims 20, 27-28 and 30 were objected to for minor informalities regarding the acronyms ETSI and TETRA. Applicant has amended the claims to include a definition of the acronyms ETSI and TETRA and respectfully request that the objection be withdrawn in the next Office Action.

Rejection of Claims

Claims 20-21 and 30-32 were rejected under 35 U.S.C. §103(a) as being unpatentable over Saijonmaa (U.S. Patent Publication No. 2004/0190468) in view of Cannon (U.S. Patent 5,257,416). Claims 22-29, 33 and 36-39 were rejected under 35 U.S.C. §103(a) as being unpatentable over Saijonmaa and Cannon in view of the Tetra standards. Claims 34-35 were rejected under 35 U.S.C. §103(a) as being unpatentable over Saijonmaa, Cannon and the Tetra standards in view of Iwamura (U.S. Patent Publication No. 2004/0184406). Applicants traverse the rejections.

Claim 20 recites a method of radio communication in which a mobile station maintains a communication group set that comprises an ordered list of multiple user groups. This list is used for scanning for radio frequency activity among at least some of the groups, which each communicate by ETSI direct mode communication on an associated direct mode RF channel (and different RF carriers) for the group. The mobile station periodically samples each of the direct mode RF channels to determine if there is any RF activity comprising a direct mode communication on the direct mode RF channel. Depending on user selection, the mobile station may be switched to a different direct mode RF channel. This selection is independent of the relative priorities of the direct mode communications on the different channels.

The Office Action cites paragraphs [0042]-[0043] of Saijonmaa disclose maintaining a communication group set comprising an ordered list of multiple user ETSI direct mode groups. Saijonmaa, however, does not anticipate or suggest such a method. Saijonmaa instead discloses a method of providing enhanced functionality between different types of networks, in one of which (public cellular based circuit/packet networks) group communications has been recently developed. To this end, Saijonmaa teaches a gateway to translate between the cellular network and devices operating in direct mode, thereby enabling the direct mode devices to participate in packet-based cellular group communication.

Turning specifically to paragraphs [0042]-[0043], Saijonmaa describes the packet-mode group communication service with relation to the various OSI levels. Later in paragraph [0042] Saijonmaa discusses that Fig. 5 illustrates how a data pipe can be established between the server applications in the group communication system 21 and the group communication applications in the node of the direct-mode network. Paragraph [0043] describes control (speech item reservation and grant) of the group for the cases in which members of a group are both in the cellular network and in the direct-mode network or solely in the direct-mode network. Thus, these paragraphs describe the functionality of the gateway and the manner in which control in a particular group is effected.

Neither paragraph, however, describes that lists of direct mode multiple groups are maintained. Nor does either paragraph disclose that the lists are maintained for the purpose of scanning for RF activity among at least some of the groups, let alone that the RF activity occurs on different RF carriers. The Office Action turns to Cannon for these features, stating that page 1, lines 41-51 disclose an ordered list that is maintained for the purpose of scanning for RF activity among the groups as well as the periodical sampling of each channel to determine if there is any direct mode RF activity.

Cannon discloses that the highest priority channel is monitored and the other channels scanned until a higher priority signal is received on another channel, and then the receiver is automatically switched to that channel. Cannon, however, does not disclose either user selection plays a role or that a group may or may not be joined

independent of the group priority (i.e., the user may decide not to join a higher priority group).

Nor does Cannon disclose that the scanning occurs in direct mode, let alone that different RF carriers are scanned in the direct mode. This latter point is specifically discussed in the background of the instant specification. The fact of the matter is that not all the facilities that a central trunked system is capable of providing in a trunked mode of operation (TMO) has previously been able to be replicated in the direct mode of operation, even if highly desirable. As the MPEP (2143.01) indicates, the mere fact that references can be combined may not be sufficient to establish prima facie obviousness. In particular, KSR states:

> As is clear from cases such as Adams, a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.* (KSR, 127 S. Ct. at 1740, 82 USPQ2d at 1396). [Emphasis added]

The Examiner's attention is drawn to *Ex parte* HALDAR et al. (Feb. 1, 2010), in which BPAI affirmed that if there is no objective teaching in the prior art, nor general knowledge generally available to one of ordinary skill in the art that would have led to the invention or why the specific problem needed to be solved, the rejection cannot be maintained. Moreover, in *In re* LEE (CAFC 2002) the CAFC rejected the contention that general conclusory statements adequately address the issue of motivation to combine, firmly stating that motivation is not be resolved on subjective belief and unknown authority. Citing W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), the court reiterated that "[i]t is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher.""

In the instant case, neither reference indicates the problem with direct mode communications indicated in the background of the instant specification. Nor would one of skill in the art be able to apply the same techniques in direct mode communications as in indirect mode communications. To construct the claimed method in direct mode is thus not merely a matter of combining the disparate elements from the references (i.e., that direct mode exists and that scanning exists) -- further modification is required to achieve the scanning and switching in direct mode operations. In this respect, the issues are not just the incorporation of the method of Cannon in the system of Saijonmaa, but rather 1) whether one of skill in the art would be able to combine the two while preserving the Tetra DMO standard and 2) whether the resulting combination would provide the method of claim 20. Neither is true in the instant case.

As the cited references do not anticipate or suggest a method in which a mobile station periodically determines if there is any radio frequency activity on direct mode communication channels, claim 20 is patentable over the cited references.

For at least similar reasons, claim 30 is similarly patentable over the cited references.

Claims 21-29 and 31-39 are dependent on allowable claims 20 and 30 respectively. Thus, claims 21-29 and 31-39 are patentable without more. To reiterate the above, in many instances, the Office Action insists that merely because the TETRA DMO specifications state some requirement, that one of skill in the art would be able to produce the result (and takes official notice). This is far from the case. Merely because a standard exists does not automatically confer to one of skill in the art the ability to create a method that complies with the standard. For example, certain references, such as that to Tetra 8.4.2.1, are not related to the disclosure. Tetra 8.4.2.1, for example, relates to multiplexing of several channels while the method the claims recites multiplexing of several resources within one channel while maintain an ongoing call, which is completely different. Nor are the procedures recited in claims 24-29 in any way referred to by the

TETRA standard. Applicant accordingly respectfully requests that if these rejections are maintained that the Examiner provide an affidavit to this effect for each claim, as required by MPEP 2144.03.

Conclusion

Applicant respectfully requests that a timely Notice of Allowance be issued in this case and such action is earnestly solicited. Should the Examiner have any questions, comments, or suggestions, the Examiner is invited to contact the Applicant's attorney or agent at the telephone number indicated below. Applicant herein petitions for any extension of time necessary for the filing of this response. Please charge any fees that may be due for this filing to Deposit Account 502117, Motorola, Inc.

Respectfully submitted,

SEND CORRESPONDENCE TO:

Motorola, Inc.
1303 East Algonquin Road
IL01/3rd Floor
Schaumburg, IL 60196
Customer Number: 22917

By: /Anthony P. Curtis/

Anthony Curtis
Attorney of Record
Reg. No.: 46,193

Telephone:847-576-1974
Fax No.: 847-576-0721
Email: acurtis@motorola.com